Remarks

The Office Action and references cited therein have been carefully reviewed. The following remarks herein are considered to be responsive thereto. Claims 1-19 remain in this application. Reconsideration of this application is respectfully requested.

The Examiner rejected claims 1, 4, 5, 7 and 9-19 under 35 U.S.C. §102 (e) as being anticipated by US Patent Application Publication No. 2003/0056215 A1 to Kanungo (Kanungo). The Examiner further rejected claims 2, 3, 6 and 8 under 35 U.S.C. §103 (a) as being unpatentable over Kanungo in view of US Patent No. 4,779,172 issued to Jimenez, et al. (Jimenez). Applicants respectfully transverse.

The publication to Kanungo discloses a method and apparatus for implementing a *virtual* remote control panel on a web page. The functionality of the web page is controlled by an applet that is downloaded in connection with the web page. Figure 3(a) illustrates an example of a display device 130 on which a web page 302 is displayed. The "web page 302 is displayed in accordance with HTML or a similar descriptive language or convention [wherein the] [w]eb page 302 includes a video area 304 and a *virtual* remote control panel 310." (emphasis added). Video data is displayed in the video area 304 and user interface elements are displayed in the *virtual* control panel 310. Further, the patent to Kanungo discloses a "remote unit 120, which is used as an *input device*." (emphasis added).

The patent to Jimenez discloses intermittent illuminated disco jewelry in which the lamp members, flasher, battery and switch are hidden within the disco jewelry. The flasher, battery and switch are removable so as to be replaced when needed. A primary

objective disclosed by Jimenez "is to provide intermittent illuminated disco jewelry that will overcome the shortcomings of the prior art devices."

In regard to claim 1, the Examiner asserts that Kanungo discloses a controller (the remote control 120 of Figure 2), wherein the remote control comprises a receiver. As stated above, Kanungo discloses a "remote unit 120, which is used as an input device." Nowhere is it taught in Kanungo that the remote unit 120 comprises a receiver or performs any operations in regard to receiving data or commands.

The Examiner further asserts that "at least one transmitter operatively associated with said at least two objects (see figure 7a) such that a control signal is transmitted to said receiver corresponding to an operation to be performed on at least one of said data sets and responsive to at least the other of said data sets, said controller being programmed to perform said operation."

However, the Examiner fails to realize that the claim language of the present invention additionally specifies that the "at least one transmitter operatively associated with said at least two objects and *responsive to a mechanical state of said at least two objects* such that a control signal is transmitted to said receiver corresponding to an operation to be performed on at least one of said data sets and responsive to at least the other of said data sets, said controller being programmed to perform said operation."

Being that the objects of Kanungo cited by the Examiner comprise a web page 302 that includes a video area 304 and a virtual remote control panel 310, the transmitter of Kanungo (which is actually the remote 120) as cited by the Examiner cannot not respond to the *mechanical state* of the virtual objects as disclosed by Kanungo. In actuality, Kanungo as presently cited by the Examiner, teaches away from the

implementation of the present invention. The remote control unit 120 of Kanungo does not comprise a receiver and therefore cannot receive a control signal that is transmitted from a transmitter. Further, Kanungo does not disclose a transmitter that transmits a control signal to the remote control unit 120, wherein the transmitter is responsive to the mechanical state of the virtual items displayed by the Kanungo invention.

In regard to claims 12, 14 and 17, the Examiner again cites Kanungo for the disclosure of "tokens" as disclosed as the objects of figure 3a. As stated above, the "tokens" or "objects" of Kanungo are virtual objects that are displayed on the web page 302. The tokens and objects of the present invention are actual physical objects. This aspect of the invention is apparent from the specification where it states, "although in the embodiments described above, data sets are associated with beads 310, it is possible to associate data sets with any kind of object. They could be tokens, game pieces, small toys, building blocks, etc." Nowhere is it taught or suggested in Kanungo that the virtual objects that are comprised within the web page display have physical components that may be manipulated within the disclosed invention.

Further, the objects of Kanungo in addition to having no physical form cannot, as presently disclosed, transmit commands to a communication station. The reason being is that the objects are virtual interpretations of the applets that have been downloaded to the set top box 101 along with a respective web page that has been download by the system. The commands from the remote control unit 120 are transmitted directly to the set top box 101 and therein processed by the applets. The display of the action merely reports the condition that has been executed within the set top box 101, and in no way is the

displayed object directly manipulated to accomplish any processing goal of the set top box 101.

For the above stated reasons, independent claims 1, 12, 14, and 17 are not rendered obvious by the cited reference of the Kanungo. Kanungo does not teach or suggest the user interface, system or methods having the features described above. Accordingly, claims 1, 12, 14, and 17 patentably distinguish over the prior art and are allowable. Claims 2-5, 13, 15, 16, and 18, being dependent upon claims 1, 12, 14, and 17, are thus allowable therewith. Consequently, the Examiner is again respectfully requested to withdraw the rejection of claims 1, 12, 14 and 17 under 35 U.S.C. § 103(a).

In regard to claim 6, the Examiner states that Kanungo disclose "every feature of the claimed invention, excluding wherein said at least two objects are tokens connected by a wire and two objects are beads." As discussed above, Kanungo does not disclose every feature of the presently claimed invention, in actuality Kanungo operates in a manner that is contradictory to the operation of the presently claimed invention.

Further, the Examiner cites the patent to Jimenez for comprising "at least two objects [that] are tokens connected by a wire and [the] two objects are beads." Further, the Examiner states Jimenez discloses in "figure 1, an intermittent illuminated disco jewelry (10) consisting of a plurality of beads-like lamp member (14) and connected by wire (16, see column 2, lines 3-16). The reason for citing the beads of Jimenez is that they provide a "system having at least two objects [that] are tokens of Kanungo [and] this would [allow] for [the] electrical connecting each of said beads-like lamp members together."

The Examiner cites Kanungo as comprising, as in the present claim language, " a console interoperable with said tokens," and "a console having a controller, a transmitter and an interface." In this instance the only controller cited by the Examiner is the remote unit 120 of Kanungo. Further, as stated above, the "tokens" or "objects" disclosed by Kanungo are virtual objects that are displayed on the web page 302. Apparently, to make up for the deficiencies of Kanungo, the Examiner cites Jimenez for the disclosure of disco beads that perform a similar function as the "objects" of Kanungo.

As presently claimed, the present invention comprises "a mechanically connected combination of tokens, each associated with a data set." Further, as presently claimed, the "controller [is] programmed such that a first mechanical configuration of one of said tokens, effective to interface said one of said tokens with said console, results in the transmission of a command indicating a data exchange operation involving said data set associated with said one of said tokens."

Nowhere is it taught in Kanungo that physical tokens mechanically interact with a console. Neither is it disclosed in Kanungo that the programming of the remote unit controller 120 is programmed in such a manner that the mechanical configuration of one of the tokens, either a virtual token (the display tokens as seen in Figure 3A) or physical token (the disco beads of Jimenez), is "effective to interface said one of said tokens with said console [resulting] in the transmission of a command indicating a data exchange operation involving said data set associated with said one of said tokens."

Applicant respectfully submits that the Jimenez reference is not proper because it is from a non-analogous art. To be considered analogous art, the references cited by the Examiner must be either in the same field as the invention or be reasonably pertinent to

the problem faced by the inventor. Applicant respectfully submits that neither of these requirements have been met in the present case.

With regard to the first prong of the non-analogous art test -- namely, whether a reference is within the field of the invention, the Federal Circuit has stated:

> We have reminded ourselves and the PTO that it is necessary to consider "the reality of the circumstances" -in other words, common sense- in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor.[1]

Thus, a case-by-case analysis must be made to determine if a person of ordinary skill would look to the fields of the references for a solution to the problem facing the inventor.[2]

In clarifying how to determine the second prong of the test -- namely, whether a reference is reasonably pertinent to the particular problem with which an inventor was involved, the Federal Circuit has stated that:

> [a] reference is reasonably pertinent if ... it is one which, because of the matter with which it deals, logically would have commended itself to the inventor's attention in considering his problem ... If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem ... [I]f it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it.[3]

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[1] *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443, 1446 (Fed. Cir. 1992).

[2] Id. See also, *In re Wright*, 848 F.2d 1216, 6 USPQ 2d 1959, 1962 (Fed. Cir. 1988) ("[A]s with all section 103 decisions, judgement must be brought to bear based on the facts of each case.").

[3] *In re Clay*, 23 USPQ 2d at 1060-1061.

With regard to the first prong of the non-analogous art test, and in view of the Federal Circuit's narrow view of what is in the same field of endeavor, it cannot be said that the Jimenez reference is within the same field of endeavor as the present invention, which is directed to a user interface. The Jimenez reference, which is directed to intermittent illuminated disco jewelry, is not even remotely related to a user interface. Thus, Applicants respectfully submit that the Jimenez reference is not in the same field of endeavor as the present invention.

With regard to the second prong of the non-analogous test, Applicant respectfully submits that the Jimenez reference is not reasonably pertinent to the particular problem with which the inventor of the present invention was involved.

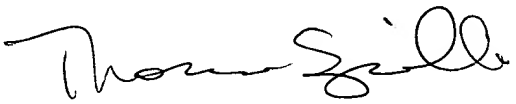
As discussed above and at length in the specification, the present invention is directed to easily programming and customizing certain electronic devices, such as a computer. This is a very different problem then faced by the inventors of the Jimenez reference. In Jimenez, the problem faced by the inventor was adapting jewelry to include battery-operated light emitting structures within the jewelry. Thus, Jimenez was not faced with the same problem as the inventor of the present invention. To paraphrase the words of the Federal Circuit, the matter with which the Jimenez reference deals, logically would not have commended itself to the inventor's attention in considering their problem. Thus, since it is directed to different purposes, the inventors would accordingly have had no motivation or occasion to consider it.

Accordingly, Applicant respectfully submits that at least the Jimenez reference is not in the same field of endeavor as the present inventions, nor is it

reasonably pertinent to the particular problem with which the inventors of the present invention were involved. Consequently, the Examiner is respectfully requested to withdraw the Jimenez reference, thereby rendering the 35 U.S.C. § 103(a) rejection of claim 6 and claims 7-11 that depend from claim 6 moot.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicant's attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



Thomas Spinelli
Registration No. 39,533

Scully, Scott, Murphy & Presser
400 Garden City Plaza
Garden City, New York 11530
(516) 742-4343
TS:WAP:jf